

REMARKS

I. Status of the Claims

Claims 1-64 are now pending in this application. Claim 8 has been amended to correct a typographical error. The claim now more clearly recites that the at least one inert organic liquid is chosen from esters of C₈-C₃₀ acids and of saturated, linear and branched C₃-C₆ monoalcohols. Support for this amendment can be found, e.g. at paragraph [040] of the as-filed specification. Accordingly, no new matter has been added.

II. Rejection under 35 U.S.C. § 112

The Examiner rejects claim 8 under 35 U.S.C. § 112, second paragraph as being indefinite "because the claim recites the limitation 'wherein the C8-C30 acid esters are chosen from saturated, linear and branched C3-C6 monoalcohols'". Office Action at 2.

Applicants have amended claim 8 to make it even more clear that the at least one inert organic liquid is chosen from esters of C₈-C₃₀ acids and of saturated, linear and branched C₃-C₆ monoalcohols. Based on this amendment, Applicants respectfully request that the rejection under § 112, second paragraph be withdrawn.

III. Rejection under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-64 under 35 U.S.C. § 103(a) as "being unpatentable over" Legrand et al. (U.S. Patent No. 6,379,401) ("*Legrand*") in view of Lorant et al. (U.S. 2003/0036490 A1) ("*Lorant*"). Office Action at 2. Specifically, the Examiner asserts that *Legrand* teaches an "anhydrous composition for bleaching keratin fibers comprising alkalizing agents such as ammonium salts, alkaline earth metal silicates as claimed in claims 1-3 and 15 (see col. 6, lines 4-7)." *Id.* at 2-3. Further, the

Examiner states that the bleaching compositions contain peroxygenated salts, an organic liquid, a water-soluble thickener, surfactants, an amphiphilic polymer, and is “obtained after mixing with the aqueous hydrogen peroxide.” *Id.* at 3. The Examiner admits that “the instant claims differ from [*Legrand*] by reciting a bleaching composition comprising a copolymer having specific monomers.” *Id.* at 4. Further, the Examiner admits that “the instant claims recite the percentage amounts of the organic liquid in the bleaching composition.” *Id.*

To cure the deficiencies of *Legrand*, the Examiner cites *Lorant*. The Examiner asserts that *Lorant*, “in an analogous art of hair treating formulation, teaches a composition comprising amphiphilic polymers comprising at least one hydrophobic portion and at least one hydrophilic portion comprising at least one ethylenically unsaturated monomer containing a sulphonic grouping free or partially or totally neutralized form as claimed in claims 1 and 28-33.” *Id.* at 4 (citing page 2, paragraphs, 0020 and 0033). Further, the Examiner asserts that the amphiphilic polymer in *Lorant* is “presented in the amounts of 0.01 to 30% by weight which covered the claimed ranges as claimed in claims 34-36.” *Id.* at 4-5 (citing page 4, paragraph, 0078). Finally, the Examiner states that *Lorant* teaches “hydrocarbon-based plant origin oils, fatty acid esters, and mineral oils as claimed in claim 7 and wherein the fatty or oily phase may range from 5 to 80%.” *Id.* at 5 (internal citations omitted).

The Examiner concludes that “in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of *Legrand* by incorporating the amphiphilic copolymers as taught by *Lorant* and to optimize the percentage amounts of the organic

liquid in the bleaching composition to arrive at the claimed invention.” *Id.* at 5. The Examiner contends that “[s]uch a modification would be obvious because the primary reference of *Legrand* teaches the use of amphiphilic copolymers and organic liquids in the bleaching composition . . .” *Id.* Additionally, the Examiner contends that the person of the ordinary skill in the art would have a “reasonable expectation of success for stabilizing the bleaching composition and to optimize the amount of the organic liquid in the bleaching composition in order to get the maximum effective amounts of these ingredients in the bleaching composition.” *Id.*

Applicants respectfully traverse the rejection. In order to establish a *prima facie* case of obviousness, an Examiner must, among other things, demonstrate that there would have been some suggestion or motivation, either in a cited reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. See M.P.E.P. § 2143. The Examiner has not made such a showing here.

In particular, it is well-established law that the motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. M.P.E.P. § 2143.01; *see, e.g., In re Napier*, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995). The Examiner has not shown, and cannot show, that such teaching and motivation for combination and/or modification flow from *Legrand* and *Lorant*. Specifically, *Legrand*’s amphiphilic polymer works in his inventive compositions to achieve superior results. Nothing in either *Legrand* or *Lorant* provides any guidance to replace this successful and useful polymer

in *Legrand* with the polymer of *Lorant*. Only improper hindsight, i.e., using the present claims as a blueprint, could lead to such a modification.

In order to support a rejection under 35 U.S.C. § 103, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with **no knowledge of the claimed invention**, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998) (emphasis added). The Examiner has not shown, and cannot show, any such reasons here, because nothing in the cited references provides any motivation to have led one of ordinary skill in the art to modify *Legrand* by replacing a polymer that is known to work specifically in **anhydrous** bleaching compositions, with a copolymer that is used in various topical compositions in *Lorant*, in which (1) bleaching is never even remotely suggested, (2) the disclosed compositions are aqueous or have an aqueous phase, and (3) the physiologically acceptable medium used comprises water in an amount ranging from 5% to 99.98% by weight (see, e.g., *Lorant*, paragraphs [0013], [0086]).

Likewise, the Examiner has not shown, and cannot show, that one of ordinary skill in the art would have been motivated "to optimize the amount of the organic liquids [of *Legrand*] in order to get the maximum effective amounts of these ingredients in the bleaching composition." Office Action at 5. The requirement for a showing of motivation to modify demands that the Examiner point out an indication that such a modification would be desirable. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1994).

Here, the mineral or plant oils disclosed in *Legrand* are described as bleaching adjuvants that can be contained in the bleaching compositions (Col. 6, lines 18-27) (emphasis added). In other words, *Legrand* does not even require the use of mineral or plant oils. Furthermore, the Examiner's broad statement that optimizing the amount of the organic liquid would have been obvious "in order to get the maximum effective amounts of these ingredients in the bleaching composition," does not provide the necessary showing of motivation to modify *Legrand* to obtain the presently claimed parameters for these ingredients. Office Action at 5.

Accordingly, for at least the foregoing reasons, the Examiner has failed to make a prima facie case of obviousness. Thus the rejection is improper and Applicant respectfully requests its withdrawal.

Conclusion

In view of the foregoing remarks and amendments, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: _____


Thalia V. Warnement
Reg. No. 39,064